

REMARKS / ARGUMENTS

Claims 1-30 are pending in the instant application. Claims 1-30 were previously presented, claims 31-39 are new claims. Claims 5, 7, 8, 15, 17, 18 and 25, 27, 28 are cancelled, and have been rewritten generally as new claims 31-39 in independent form, with some clarifying changes. Claims 1, 11, 21 and 26 have been amended to clarify the claim language. The Applicant points out that the amendments are supported in at least Figs. 2 to 7, and related descriptions. Claims 1, 11 and 21 are independent claims. Claims 2-4, 6, 9-10, 12-14, 16, 19-20 and 22-24, 26 and 29-30 depend directly or indirectly from claims 1, 11 and 21 respectively.

Claims 1-4, 6, 9, 11-14, 16, 19, 21-24, 26 and 29 are rejected under 35 U.S.C. § 102(a) as being anticipated by the Applicant's admitted prior art ("APA").

Claims 10, 20 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over "APA" in view of USP 5,923,663 ("Bontemps").

Claims 5, 7-8, 15, 17-18 and 25, 27-28 are objected to as being dependent upon a rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. Examiner's Response to Arguments

At page 5 of the Final Office Action, the Examiner argues that the Applicant's Fig. 1 (i.e., Applicant's admitted prior art or "APA") reads on "determining any one usable media pair from all existing media pairs," in Applicant's claim 1. The Applicant respectfully disagrees.

More specifically, the Examiner alleges that the two respective controllers 110 and 112, each with two media pairs as input, are the "all existing media pairs" to the respective controllers 110 and 112. The Examiner argues that the respective controllers 110 and 112 are independent devices. In other words, the Examiner seems to allege that the respective controllers 110 and 112, is an auto-MDIX system. This interpretation is contrary to the disclosure in APA.

The Examiner is referred to Fig. 1 (i.e., "APA") and ¶11 of Applicant's specification, where APA clearly discloses that the auto-MDIX system includes the respective controllers 110 and 112. In other words, APA discloses that there are four media pairs as input to the auto-MDIX system. Therefore, the Examiner's alleged device should be referred to the auto-MDIX system, not the individual controllers 110 or 112. In this regard, the four media pairs input are the "all existing media pairs" to the auto-MDIX system (i.e., the alleged "device"). Since each of the respective **controllers 110 or 112 utilizes only two out of the four media pairs input**, the respective controllers 110 or 112 **do not** perform

"determining any one usable media pair from all **(four)** existing media pairs"
(emphasis added).

The Examiner is further referred to Applicant's Fig. 2, which clearly discloses that there are four media pairs as "all existing media pairs" input to a controller 210 in an auto-MDIX reconfigure and repair system. In this regard, APA **does not** disclose "**determining one usable media pair from all (four) existing media pairs**". Accordingly, the Applicant maintains that APA does not anticipate Applicant's claim 1.

Nevertheless, for the sake of advancing prosecution, the Applicant has amended the claim language of claim 1 for clarification, where claim 1 now reads "determining any one usable media pair from all existing media pairs; ... wherein **the device communicates using at least three media pairs of said all existing media pairs**". The Applicant points out that the amendments are supported by at least Figs. 2 to 7 and related descriptions. For example, controller 210 of the Auto-MDIX system in Fig. 2 communicates to four media pairs: Pair 1 to Pair 4.

The Applicant submits that the amended claim 1 is further distinguished from APA. The Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. 102(a) be withdrawn.

II. REJECTION UNDER 35 U.S.C. § 102

With regard to the anticipation rejections under 102, MPEP 2131 states that:

"[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

A. The APA Does Not Anticipate Claims 1-4, 6, 9, 11-14, 16, 19, 21-24, 26 and 29

The Applicant now turns to the rejection of claims 1-4, 6, 9, 11-14, 16, 19, 21-24, 26 and 29 under 35 U.S.C. 102(a) as being anticipated by APA. Without conceding that APA qualifies as prior art under 35 U.S.C. 102(a), the Applicant respectfully traverses this rejection as follows.

A(1). Independent Claims 1, 11 and 21

With regard to the rejection of independent claim 1 under 35 U.S.C. §102(a), the Applicant submits that APA does not disclose or suggest at least the limitation of "determining any one usable media pair from all existing media pairs;... wherein the device communicates using at least three media pairs of said all existing media pairs", as recited in Applicant's claim 1. The Final Office Action states that the above claim limitation is anticipated by APA as follows:

"APA discloses ...determining any one usable media pair from all existing media pairs (see APA [04], lines 1-6, auto-NMIX reconfigure

channels to properly reassign the media pairs to channels, therefore a usable media pair is determined from all existing media pairs , see also [12], and fig. 1, the first controller and the second controller is independent and all existing media pair for each controller are independent devices))”

See Final Office Action at page 2. The Examiner relies for support on the Applicant’s paragraph [04], lines 1-6, which states:

In a typical 4-pair conductor or wire system, auto-MDIX may be adapted to automatically detect the order of media pairs 1 and 2 and in certain instances, auto-MDIX *may reconfigure only certain channels* so as to properly re-assign the transmit/receive media pairs to these channels. Auto-MDIX may also be adapted to reconfigure channel ordering for *certain channels* in order to mitigate the effects of improper interfacing and/or configuration. [Emphasis added].

See the Applicant’s paragraph [04], lines 1-6. The Examiner erroneously equates each of the two controllers 110, 112 shown in APA, to the auto-MDIX system, and calling it an “independent device”. Consequently, the Examiner erroneously equates the two media pairs (i.e., media pair 1 and 2) coupled to the first controller 110 (i.e., the alleged “first device”) to “all existing media pairs”.

The Applicant respectfully disagrees, and refers the Examiner to the Applicant’s arguments in section I above, that controller 110 is only a part of the auto-MDIX system. In this regard, the controller 110 (i.e., the alleged “first device”) only utilizes **two** of the “**all existing media pairs**”.

Furthermore, claim 1 now reads “determining any one usable media pair from all existing media pairs; ... wherein **the device communicates using at least three media pairs of said all existing media pairs**”. The Applicant submits

that claim 1 is further distinguished from APA. The Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. 102(a) be withdrawn.

Independent claims 11 and 21 are similar in many respects to independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1, 11 and 21.

A(2). Dependent Claims 2-4, 6, 9, 12-14, 16, 19 and 22-24, 26 and 29

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 102(a) as being anticipated by the APA has been overcome, and requests that the rejection be withdrawn. Additionally, claims 2-4, 6, 9, 12-14, 16, 19 and 22-24, 26 and 29 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable. The Applicant maintains the arguments of the 10/27/08 reply to the Office Action to the above claims.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

A. The Proposed Combination of “APA” and Bontemps Does Not Render Claims 10, 20 and 30 Unpatentable

Claims 10, 20 and 30 are rejected under 35 U.S.C. §103(a) over APA, in view of Bontemps.

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 102(b) as being anticipated by the APA has been overcome, and requests that the rejection be withdrawn. Additionally, claims 10, 20 and 30 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable. The Applicant maintains the arguments of the 10/27/08 reply to the Office Action to the above claims.

Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-4, 6, 9-14, 16, 19-24, 26 and 29-30.

IV. Objection to Claims 5, 7-8, 15, 17-18, 25, 27-28

Claims 5, 7-8, 15, 17-18, 25, 27-28 are objected to as being dependent upon a rejected base claims. The Applicant has cancelled claims 5, 7-8, 15, 17-18, 25, 27-28, has rewritten the cancelled claims into independent form as corresponding claims 31-39, with some clarifying changes. The Applicant submits

Application No. 10/612,729

RCE-Reply to Final Office Action of January 29, 2009

that claims 31-39 are in condition for allowance.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-4, 6, 9-14, 16, 19-24, 26, 29-30 and 31-39 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: April 1, 2009

/ Frankie W. Wong /

Frankie W. Wong
Registration No. 61,832
Patent Agent for Applicant

McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(312) 775-8093 (FWW)